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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,657

01/21/2004

Su Chen

CHEN-0002

5157

50010 7590 01/15/2008
LAW OFFICE OF MICHAEL A. BLAKE
112 BROAD STREET
MILFORD, CT 06460

EXAMINER

BARNHART, LORA ELIZABETH

ART UNIT

PAPER NUMBER

1651

MAIL DATE

DELIVERY MODE

01/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10762657	1/21/04	CHEN ET AL.	CHEN-0002

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EXAMINER

Lora E. Barnhart

ART UNIT**PAPER**

1651

20080110

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

OFFICE COMMUNICATION

The reply received 10/29/07 is non-responsive (MPEP § 821.03). Since applicant has received an action on the merits for the originally presented invention, *i.e.*, a composition, this invention has been constructively elected by original presentation for prosecution on the merits. See the Office action mailed 12/23/04, page 3. Accordingly, claims 1-4 as currently drafted are directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. Claims 1-4 are not readable on the elected invention because they are drawn to a method of preparing polyunsaturated fatty acid-containing phosphatidylserine, *i.e.* a method of making the composition examined in the first Office action on the merits.

Applicants dispute the Examiner's finding of election by original presentation and allege that there is no shift in invention, citing M.P.E.P. § 820 (Reply, page 2). However, the examiner respectfully submits that applicants are misinterpreting this section of the M.P.E.P. The portion cited by applicants indicates that there is no shift "where the **examiner holds** the invention to be in the process" (emphasis added). Such is not the case in this application. In the Office action mailed 12/23/04, the examiner clearly indicated that she was interpreting the invention as being "a composition of highly unsaturated fatty acid-containing phosphatidylserine and phosphatidic acid" that may be produced by particular steps (see the Office action at pages 3 and 5). The examiner further explained that product-by-process limitations do not necessarily impart distinctive structural characteristics to the claimed product (see the Office action at page 4). The examiner explicitly stated in the Office action that the invention was

interpreted as being drawn to a composition, not to a process. The examiner did not hold that the invention is in the process. Only the product was examined; no process steps per se were examined for patentability. This point was reiterated in the Office communication mailed 9/27/07.

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made **and action given** on the elected subject matter, in this case the composition comprising phosphatidylserine and phosphatidic acid. See MPEP § 819. The examiner clearly indicated that the product, and not any method, was being examined in the first Office action. Shifting to a method at this point in prosecution is not a matter of right. The claim listing submitted 12/22/06 is a shift in invention.

Since the above-mentioned amendment appears to be a bona fide attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lora E. Barnhart whose telephone number is 571-272-1928. The examiner can normally be reached on Monday-Thursday, 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Wityshyn can be reached on 571-272-0926.

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The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Lora E Barnhart
Patent Examiner

A handwritten signature in black ink, appearing to read 'Lora E. Barnhart', with a stylized flourish at the end.